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| EXAMINER |
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VENKAT, JYOTHSNA A

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| ART UNIT | PAPER NUMBER |
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1615

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,987

Applicant(s)

FERRARI, VERONIQUE

Examiner

JYOTHSNA A VENKAT

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 65,88-135 and 147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 65,88-135 and 147 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/10/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Receipt is acknowledged of letter informing about the litigation and amendment and IDS filed on 7/23/04 and 6/10/04 respectively. Claims 66-87 and 136-146 have been canceled and claim 147 has been added as per applicant's amendment dated 6/10/04. Claims 65, 88-135 and 147 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 65, 88-135 and 147 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 5,998, 570('570); 6,749,173('173); 6,224,851('851); 6,399,080('080) and 6,203,780('780).

The instant application is claiming a structured composition, gel composition, product, and lipstick comprising liquid fatty phase comprising:

1. Fluoro oil. The species are claimed as formulae II-XII in claims 90-112.
2. polymer. The species belonging to this polymer is claimed as formula I in claims 85-87.
3. additional oil . Claims 117-125
4. apolar oil of claims 126-127
5. dyestuff
6. additive

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The patent '570 teaches formula I, which is ingredient 2, claimed in cosmetic products. See cols 2-5, see col.16, lines 13-33 for apolar oils. The patent at col.3, lines 44-46 teaches that this polymer can be used in personal care products like lipstick, foundation make up and eye make up which includes mascara claimed in the instant application along with lipstick. See col.17, lines 42-48 for the additives. The patent does not teach ingredients 1 and 3-5. However patent '173 teaches lipstick-using 1 which is formulae II-III along with ingredients 3-6. See col.4, lines 25 et seq for the fluoroil species and see col.s 5-6 for 3-4 and see col.col.8 for 5-6 and see the examples. The patent '851 teaches fluoro oils of formulae IV-IX in cosmetic products as transfer resistant agents. See col.s 2-4 and see the examples. The patent '080 teaches formula X in cosmetic compositions along with formulae IV, VIII and IX. See col.s 1-2. the formula X corresponds to formula IV of the patent and formulae IV, VIII and IX correspond to formulae I-III respectively. The patent also teaches 3-6. See cols. 4 and see the paragraph bridging cols. 5-6 for dyestuff and see col.7, lines 52-57 for various additives. The patent '780 teaches fluoro oil which is formulae XI and XII along with ingredients 3-6. See col.3, lines 1-37 for oils, see col.7 last paragraph for additives and see col.8, lines 31-52 for the dyestuff.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '570 and combine it with the *fluoro oils* of '6,749,173('173); 6,224,851('851); 6,399,080('080) and 6,203,780('780). expecting beneficial effect to the cosmetic products when applied. The motivation to use the *fluoro oils of the various patents stems from the teaching of these patents that these fluoro oils are transfer resistant agents*. One of ordinary skill in the art would certainly be motivated to combine the ingredients with reasonable amount of success, because both the main ingredients 1

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and 2 are used individually in the cosmetic products like lipstick and eye make up and the combination of the fluoro oils with the polymer would yield a transfer resistant product with the advantages of having a transparent material. The idea of combining the ingredients flows logically from the art. This is a prima facie case of obviousness.

Response to Arguments

3. Applicant's arguments filed 6/10/04 have been fully considered but they are not persuasive.
4. Applicants argue that that none of the secondary references in combination with patent '570 teach or suggest the claimed invention and argue with respect to each secondary reference.
5. Applicants admit that '173 teaches the use of hydrocarbon oil, but argue that example 1 uses only 12% and therefore one of ordinary skill in the art, when attempting to formulate a transfer-free composition, would, if anything, be led to add less hydrocarbon oil to the composition rather than more.
6. In response to the above argument, it is the examiners position that the patent is valid for the entire disclosure and to examples. Additionally, the patent '173 is relied not only for the teaching of Fluoro oil and also hydrocarbon oil.

Applicants argue that patent '080 does not teach or suggest adding hydrocarbon oils to a composition comprising Fluoro oils, absent Fluoro waxes and the patent 'teaches teaches oil range as 0-50% and better still 0-20% and therefore one of ordinary skill in the art would not led to combine led to combine the 50-955 oil of '687with fluoro oils of the patent '780.

In response to the above argument, it is the position of the examiner that patent '570 teaches the use of the polyamide polymer and hydrocarbon oil (apolar oil). Patent '080 teaches

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the use of Fluoro oils and the instant application claiming “ comprising “ is inclusive of Fluoro waxes in major amounts.

Applicants argue that ‘851 patent does not teach or suggest that hydrocarbon oil may be added in majority percentage to composition comprising Fluoro oils and none of the examples incorporate hydrocarbon oil.

In response to the above argument, it is the position of the examiner that the rejection is based upon the combination of the patents and not on patent ‘851 alone. Patent ‘851 teaches at col.3, lines 60-65 that the fatty phase can be between 0.3 to 90 %and at col.4 teaches various oils. The patent is valid for the entire disclosure and not for the examples. The patent ‘851 is relied for the teaching of Fluoro oil claimed in the instant application and also fatty phase claimed in the instant application.

Applicants did not argue with respect to patent ‘780 except for the statement that the office has failed to show that the teachings of any of the cited patents would have provided a reasonable amount of success.

In response to the above argument, it is the position of the examiner that the examiner provided motivation as well as reasonable expectation of success. One of ordinary skill in the art would certainly be motivated to combine the ingredients with reasonable amount of success, because the polymer and Fluoro oils are used individually in the cosmetic products like lipstick and eye make up and the combination of the fluoro oils with the polymer would yield a transfer resistant product with the advantages of having a transparent material since patent ‘780 teaches that the polymers when blended with hydrocarbon (fatty phase) exhibit gel consistency and when

this is combined with fluoro oils the compositions has the advantage of transfer resistant properties.

7. Additionally applicants argue against the references individually and it is the position of the examiner that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

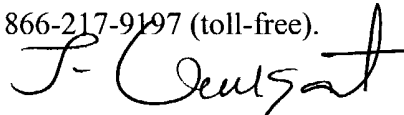
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT
Primary Examiner
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